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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,485	02/05/2004	Thomas A. Jesko	WBA.P.3115 A	4987

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EXAMINER	
HORTON, YVONNE MICHELE	
ART UNIT	**PAPER NUMBER**
3635	

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/772,485	JESKO, THOMAS A.	
	Examiner	Art Unit	
	Yvonne M. Horton	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 May 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

The indicated allowability of the claims is withdrawn in view of the newly discovered reference(s) to HEIN. Rejections based on the newly cited reference(s) follow.

Claim Objections

Claims 1-47 are objected to because of the following informalities: the claims continuously details "a gap"; however, it is not clear from the claim if the "gap" that is continuously mentioned is the same or different "gap". Clarification and appropriate correction is required.

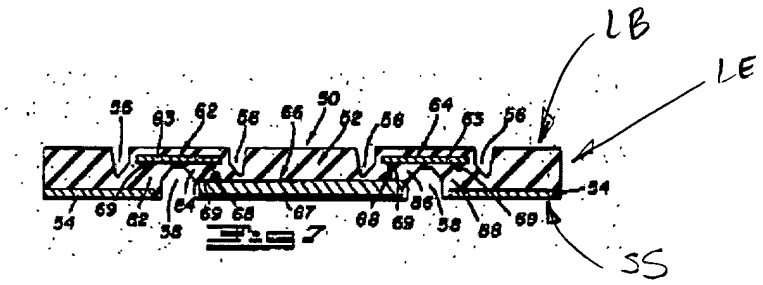
Claim 47 is also objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 47 does not incorporate any method steps. The method needs to say something similar to --allowing deformation-- or --applying a biasing force--.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

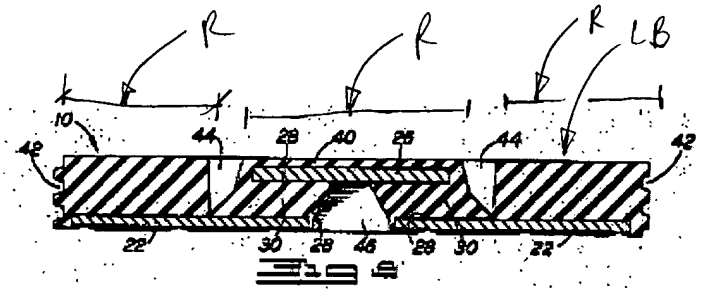
Claims 1,3,5,6,8,9,11,13,14,31,33,35,36,38,39,46 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #3,758,220 to HEIN. In reference to claims 1 and 31, HEIN discloses an elongated resilient cover (10,20) having a load bearing surface (LB), column 4, lines 14-15, opposite a supporting surface (SS), see below, and including rigid plate (21) encapsulated therein, and a plurality of fasteners (8) engaging the cover (10,20) at spaced apart locations along the lateral sides thereof



to thereby secure the cover; wherein the cover (10,20) has a thickness sufficient to elastically deform the cover (10,20) by bending/flexing the cover (10,20), column 2, lines 55-62. In reference to claims 3 and 33, the load bearing surface (LB) includes spaced apart upstanding ribs (15) arranged transversely thereacross in the direction of traffic. Regarding claims 5 and 35, the cover (10,20) is made from an elastomeric material, column 3, lines 56-57. In reference to claims 8,9,38 and 39, the cover (10,20) further includes at least two rigid plate members (23,54) also encapsulated therein and extending along opposing lateral edges (LE), see above; wherein the plate members (23,54) are provided to allow elastomeric deformation of the cover (10,20) and inherently apply a biasing force in a direction to urge the lateral sides (LE) downward

towards an underlying horizontal surface while deforming the traffic traversing load bearing surface (LB), see figures 1 and 4, and column 4, lines 11-39. The applicant is reminded that the manner in which a device is intended to be employed does not differentiate the claimed apparatus from a prior art device satisfying the claims structural limitations. Also, claim 9 is replete with functional language. The applicant is further reminded that the method of forming a device or the method of how a device performs is not germane to the issue of patentability of the device itself. Thus, the ability of the cover to apply a biasing force and be urged are not method steps considered while determining patentability of the apparatus which is a cover assembly. Should the applicant seek patent protection for these method or functional steps, he must claim the element as a "means" for performing the designated function. Regarding claim 11, the load bearing surface (LB) includes spaced apart upstanding ribs (15) arranged transversely thereacross in the direction of traffic. In reference to claims 6,13,14 and 36, the cover (10,20) is made from an elastomeric material, column 3, lines 56-57, that is specifically ethylene-propylene rubber, column 6, lines 4-6. Regarding claims 46 and 47, HEIN discloses the method of installing the aforesaid cover assembly (10,20) including the steps of providing the cover (10,20), establishing supporting contact, and placing the cover across the gap. Further regarding claim 47, HEIN, as mentioned earlier, discloses inherently apply a biasing force in a direction to urge the lateral sides (LE) downward towards an underlying horizontal surface while deforming the traffic traversing load bearing surface (LB), see figures 1 and 4, and column 4, lines 11-39.

Claims 16,18,20,23,24,46 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #3,862,810 to WELCH. WELCH discloses an elongated resilient cover (10), a rigid plate (18,26,32) encapsulated therein each having a predetermined width sufficient to overlie portions of horizontal members outwardly of marginal areas of a gap therebetween, column 3, lines 31-56, and a plurality of fasteners (column 3, lines 60-65) engaging the cover (10) at spaced apart locations along the lateral sides thereof to thereby secure the cover (10). In reference to claim 18, the load bearing surface (LB), see below, includes spaced apart upstanding ribs



(R), formed by grooves (14,44) and as at regions (12,40), arranged transversely thereacross in the direction of traffic. Regarding claim 20, the cover (10) is made from an elastomeric material, column 4, lines 64-65 and the last line in column 4. In reference to claim 23 and 24, the cover (10) further includes at least two rigid plate members (20,22) also encapsulated therein and extending along opposing lateral edges (42); wherein the plate members (20,22) are provided to allow elastomeric deformation of the cover (10) and inherently apply a biasing force in a direction to urge the lateral sides (42) downward towards an underlying horizontal surface while deforming the traffic traversing load bearing surface (LB), column 4, lines 11-14 and 24-27.

Regarding claims 46 and 47, WELCH discloses the method of installing the aforesaid cover assembly (10) including the steps of providing the cover (10), establishing supporting contact, and placing the cover across the gap. Further regarding claim 47, WELCH, as mentioned earlier, discloses inherently apply a biasing force in a direction to urge the lateral sides (42) downward towards an underlying horizontal surface while deforming the traffic traversing load bearing surface (LB), column 4, lines 11-14 and 24-27.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

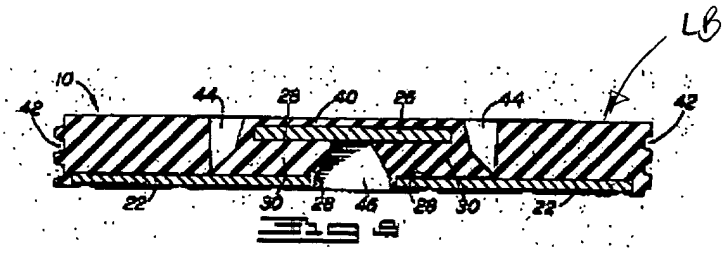
The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2,4,7,10,12,15,32 and 40-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,758,220 to HEIN. As detailed above, HEIN discloses the basic claimed cover assembly except for the cover having tapered lateral sides; except for the fasteners explicitly being screws, nails, or rivets; and except for the

elastomeric material explicitly being ethylene-propylene-diene rubber. In reference to claims 2,10,32 and 40, although HEIN does not detail tapered lateral side, it would have been obvious to one having ordinary skill in the art at the time the invention was made to taper the side edges of the cover of HEIN in order to provide the cover with an ease of insertion within the gap formed between the spaced structural members. Tapers are known in the art for allowing items to be wedged easily and provides for better maneuverability. Regarding claims 4,12,34 and 42, although HEIN merely details the use of fasteners, screws, nails and rivets are well recognized art equivalents. Hence, it would have been obvious to one having ordinary skill in the art to select a known fastener suitable for the use intended. For instance, if the cover is being employed in an area known for being exposed to a certain amount of vibration, perhaps a screw would be more profitable rather than a nail because the vibrations might cause the nails to work free from the device. In reference to claims 7,15,37 and 45, HEIN details the use of ethylene-propylene rubber, column 6, lines 4-6; however, he does not detail the use of specifically ethylene-propylene-diene rubber. Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known material on the basis of its suitability for the use intended as an obvious matter of design choice. Regarding claim 41, the load bearing surface (LB) includes spaced apart upstanding ribs (15) arranged transversely thereacross in the direction of traffic. In reference to claims 5,35,43 and 44, the cover (10,20) is made from an elastomeric material, column 3, lines 56-57.

Claims 17,19 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,862,810 to WELCH. As detailed above, WELCH discloses the basic claimed cover assembly except for the cover having tapered lateral sides; except for the fasteners explicitly being screws, nails, or rivets; and except for the elastomeric material explicitly being ethylene-propylene-diene rubber. In reference to claims 17 and 25, although WELCH does not detail tapered lateral side, it would have been obvious to one having ordinary skill in the art at the time the invention was made to taper the side edges of the cover of WELCH in order to provide the cover with an ease of insertion within the gap formed between the spaced structural members. Tapers are known in the art for allowing items to be wedged easily and provides for better maneuverability. Regarding claims 19 and 27, although WELCH merely details the use of fasteners, screws, nails and rivets are well recognized art equivalents. Hence, it would have been obvious to one having ordinary skill in the art to select a known fastener suitable for the use intended. For instance, if the cover is being employed in an area known for being exposed to a certain amount of vibration, perhaps a screw would be more profitable rather than a nail because the vibrations might cause the nails to work free from the device. In reference to claim 26, the load bearing surface (LB), see below, includes spaced apart upstanding ribs



(R), formed by grooves (14,44) and as at regions (12,40), arranged transversely thereacross in the direction of traffic. Regarding claim 28, the cover (10,20) is made from an elastomeric material, column 3, lines 56-57.

Claims 21,22,29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #3,862,810 to WELCH in view of US Patent #3,758,220 to HEIN or US Patent #3,363,522 to GALBREATH. Regarding claims 21 and 29, WELCH discloses the basic claimed cover assembly except for explicitly detailing the use of ethylene-propylene rubber. Both HEIN and GALBREATH teach that it is known in the art to form a cover assembly (10,20) or (10) out of ethylene-propylene rubber, column 6, lines 4-6, HEIN; and column 5, line 46-47, GALBREATH. . Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the cover assembly of WELCH out of the materials taught by either HEIN or GALBREATH in order to form a cover that is resilient, capable of carrying a load thereon, and that is non-corrosive. In reference to claims 22 and 30, although both HEIN and GALBREATH detail the use of ethylene-propylene rubber, neither specifically detail the use of ethylene-propylene-diene rubber. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known material on the basis of its suitability for the use intended as an obvious matter of design choice.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (571) 272-6845. The examiner can normally be reached on 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yvonne M. Horton
Art Unit 3635
8/31/05